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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/420,434	10/18/1999	DORON FRIEDMAN	F0011/7000	2811

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EXAMINER

JEAN, FRANTZ B

ART UNIT	PAPER NUMBER
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2151

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/420,434	FRIEDMAN ET AL.	
	Examiner	Art Unit	
	Frantz B. Jean	2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07/01/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-19, 25 and 27-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-19, 25, 27-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

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This office action is in response to the amendment filed on 07/01/2002. Claims 1-12, 20-24 and 26 have been canceled. Claims 13-19, 25, and 27-54 are pending in this application.

The amendment filed on 07/01/2004 has been entered.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 13-19, 25, 27-29, 31-36, 38-39, 41-50 and 52-54 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of copending Application No. 10/646,095.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the independent claims of application "095" recite all the limitations of the instant application which encompasses the same metes and bounds. It has been held that omission of an element and its function and a combination where the remaining elements performs the same function as before involves only routine skill in the art. See *in re Karlson*, 136 USPQ 184.

Claims 13-19, 25, 27-29, 31-36, 38-39, 41-50 and 52-54 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of copending Application No. 10/647,705. Although the conflicting claims are not identical, they are not patentably distinct from each other because the independent claims of application "705" recite all the limitations of the instant application which encompasses the same metes and bounds. It has been held that omission of an element and its function and a combination where the remaining elements performs the same function as before involves only routine skill in the art. See in re Karlson, 136 USPQ 184.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 13-19, 25, and 27-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Small US patent Number 5,513,117 and Chaturvedi A Das et al. (EP 0784394A1). Applicants IDS.

As per claims 13-19, 25, and 27-54, Small teaches the entire concept of : (1) coordinating a combined matching of a card and an item (gift) ordered on line from a

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vendor web site and a data identifying the location where the item ordered on line physically resides and where the card is to be printed and matched with the item ordered on line for shipment as a combined card and an item parcel; (2) authorizing printing of the card in combination with the modification at a remote location where the item that has been ordered on line from one of a vendor web site and the first web site physically resides and with which the card is associated and authorizing matching and shipment of the card in conjunction with the item that has been ordered on line as a combined package, (3) program logic configured to receive data associating the card with an item that has been ordered on line from a vendor web site and a program logic configured to transmit, over a computer network to a system located where the item ordered on line is located, the data identifying the card and any modifications to the card, and the data associating the card with the item that has been ordered on line, and program logic configured to print the modified card to enable matching and shipment of the printed modified card with the item ordered on line as a combined package see : (Small abstract; col. 4 line 50 to col. 10 line 40) and (Chaturvedi abstract and summary of the invention at col. 1 line 50 to col. 2 line 6; see also the detailed description of the invention).

Claims 13-19, 25, and 27-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Simpson US patent Number 6,453,300. (Applicants' IDS)

As per claims 13-19, 25, and 27-54, Simpson teaches the entire concept of (1) coordinating a combined matching of a card and an item (gift) ordered on line from a

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vendor web site and a data identifying the location where the item ordered on line physically resides and where the card is to be printed and matched with the item ordered on line for shipment as a combined card and an item parcel; (2) authorizing printing of the card in combination with the modification at a remote location where the item that has been ordered on line from one of a vendor web site and the first web site physically resides and with which the card is associated and authorizing matching and shipment of the card in conjunction with the item that has been ordered on line as a combined package, (3) program logic configured to receive data associating the card with an item that has been ordered on line from a vendor web site and a program logic configured to transmit, over a computer network to a system located where the item ordered on line is located, the data identifying the card and any modifications to the card , and the data associating the card with the item that has been ordered on line, and program logic configured to print the modified card to enable matching and shipment of the printed modified card with the item ordered on line as a combined package see (Simpson abstract and summary of the invention).

Response to Arguments

Applicant's arguments filed 07/01/2004 have been fully considered but they are not persuasive.

Applicants argued that Small, Chaturvedi and Simpson do not teach ordering a personalized card and a gift separately on line and shipping them as a single package to the same recipient.

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Examiner believes that all three prior art, especially Chaturvedi and Simpson, teach the concept and limitations of the claimed invention as written. Chaturvedi discloses delivery of personalized card with flower arrangement (gift). Simpson, however, provides a selection of gifts to be chosen by a user along with personalized card to be delivered both to a recipient (see col. 3 et seq). Accordingly, the previous rejection is maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz B. Jean whose telephone number is 703 305 3970. The examiner can normally be reached on 8:30-6:00 M-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 703 308-6687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Frantz Jean



FRANTZ B. JEAN
PRIMARY EXAMINER